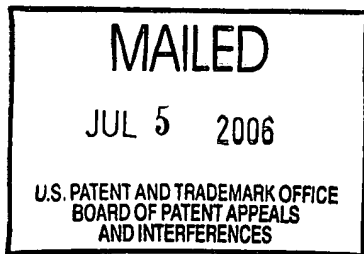


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JOHN R. MOODY

Application 10/004,823

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 1, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on January 11, 2006.

37 CFR § 41.37(c)(1)(v) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 2-5 of the Appeal Brief filed January 11, 2006 is deficient because it does not map the claimed invention to all of the independent claims. Correction is required.

An Examiner's Answer was mailed March 22, 2006 in response to the Appeal Brief filed January 11, 2006. Clarification is requested regarding the conflicting statements appearing in the "Summary of Claimed Subject Matter" on page 2 (i.e., "[t]he summary of claimed subject contained in the brief is correct" and "[t]he summary of claimed subject matter contained in the brief is deficient"). In addition, the conflicting statements appearing on pages 2 and 3 under the heading "Grounds of Rejection to be Reviewed on Appeal" need to be clarified (i.e., "[t]he copy of the appealed claims contained in the Appendix to the brief is correct" [page 2] and "[t]he appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct" [page 3]).

Finally, the first sentence appearing in the final paragraph under the "Grounds of Rejection to be Reviewed on Appeal" (page 3) is incomplete because it only refers to 37 C.F.R. and does not include a section number. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) for notification to appellant to submit a substitute Appeal

Brief which corrects the "Summary of claimed subject matter";

- 2) for consideration of the substitute Appeal Brief; and
- 3) for clarification regarding the proper status of the "Summary of Claimed Subject Matter";
- 4) for clarification regarding the proper status of the "Grounds of Rejection to be Reviewed on Appeal";
- 5) for completing the reference to 37 C.F.R. appearing in the "Grounds of Rejection to be Reviewed on Appeal";
- 6) for notification to appellant regarding the action taken; and
- 7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

DALE M. SHAW

Deputy Chief Appeal Administrator
(571) 272-9797

DMS:psb

Ferrells, PLLC
P.O. Box 312
Clifton, VA 20124-1706